

## C. REMARKS

This Reply is in response to the Office Action mailed on November 14, 2006 in which claims 1-14 and 51-64 were rejected. Claims 1-14 and 51-64 are presented by the Applicants for reconsideration and allowance.

### 1. *REJECTION OF CLAIMS 1-3, 5, 7, 9, 10 AND 51-64 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN*

Section 2 of the Office Action rejected claims 1-3, 5, 7, 9, 10 and 51-64 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* (U.S. Patent No. 5,570,882) in view of *Martin* (U.S. Patent No. 4,570,931). Claim 1 is an independent claim and claims 2, 3, 5, 7, 9, 10 and 51-64 depend from claim 1.

Applicants maintain their position stated in the Amendments filed on February 23, 2006 and September 16, 2006. Applicants respectfully submit that claims 1-3, 5, 7, 9, 10 and 51-64 are non-obvious and patentable over *Horkan* and *Martin*, either alone or in combination, because there is no suggestion to combine these references.

*Horkan* and *Martin* not only lack a suggestion to combine, but *Horkan* actually *teaches away* from a combination with *Martin*. A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged, or led in a direction divergent, from the path that was taken by the applicant. *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (*citing In re Gurley*, 27 F.3d 551, 552-53 (Fed. Cir. 1994)). “[A] reference will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought.” *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004). *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005). “[A]n applicant may rebut a *prima facie* case of obviousness by showing that the prior art *teaches away* from the claimed invention *in any material respect*.” *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) (*emphasis added*), *In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005).

*Horkan* seeks a high level of engagement between the gloved fingertips of the user and the lacing of a modified football, and exclusively teaches that this high level of engagement occur *only* at and between the Velcro® patched fingertips of the gloved user and the lacing of the training football having corresponding Velcro® material. *Horkan* also teaches that the engagement level between the remaining surfaces of the training football and the remaining surfaces of the corresponding gloves be significantly lower to ensure that proper gripping of the training football by the young football player occurs *only* at the connection of the gloved fingertips of the user and the lacing of the training football.

*Horkan* also teaches away from a combination with *Martin* and from the claimed invention. *Horkan* teaches away from increasing the grippability of the exposed surface of the lacing for contact directly with the user's hands, as required by the claimed invention. *Horkan* does not teach generally increasing the grippability of a football or of the lacing of a football. Rather, *Horkan* wishes to avoid generally increasing the grippability of the football and/or the laces to a user hands in general. *Horkan* teaches only increased grippability between the gloved fingertips of the user and the lacing of the training football. *Horkan*'s objective is to ensure proper hand positioning of the user to the training football so that the young player learns the correct hand position for throwing the training football.

The Abstract very clearly states *Horkan*'s objective. "The football is grasped by a user *wearing a glove* having Velcro® hook elements *only at the fingertips* thereof. The *restriction* of the Velcro® elements *to the football lacing and the fingertips of the glove* urges the user to grasp the football *only* at the laces so as to impart a proper spin thereto upon subsequent throwing." Abstract (*emphasis added*). *Horkan*'s objective teaches away from generally improving the grippability of the outer surface of the lacing to the hands of a user in general. As reiterated in the background of the invention, improving the contact between a training football and a gloved (or ungloved) user is undesirable. Rather, the improved contact or grippability must occur **only and exclusively** between the lacing and the fingertips of the gloved user.

*I have invented* a training aid in the form of *a modified football and glove*. The modified football utilizes lacing having one element of a Velcro® fastener combination thereon. *A flexible glove has* the complementary *mating elements* of Velcro® fastener combination *only at the fingertips* thereof. The use of the Velcro *only* on the laces *forces* the *gloved* user to properly grasp the football only at such laces.

Col. 1, lines 41-47 (*emphasis added*).

One of ordinary skill in the art, upon reading *Horkan*, would be discouraged and led in a direction divergent from the path that was taken by present Application. One of ordinary skill in the art, upon reading *Horkan*, would quickly recognize that the line of development flowing from *Horkan's* disclosure would be unproductive of the result sought in the present Application. As discussed above, *Horkan* teaches away from the claimed invention in many material respects.

Additionally, Applicants have shown that the frictional engagement between corresponding (mating) Velcro® materials is significantly higher than the engagement of Velcro® materials with other non-mating surfaces. In fact, Velcro® materials alone (when not used with corresponding, complementary or mating Velcro® materials) have coefficient of friction values that are significantly lower than commonly used game ball materials, such as artificial leather or natural leather. Therefore, *Horkan* does not in anyway teach increasing the grippability of the lacing of a football to the hands of a user. In fact, *Horkan* teaches the opposite. *Horkan* teaches away from the use of surfaces that are highly grippable when directly contacted by a user's hands as required by the claims.

If one were to combine the pebbled surface of the basketball of *Martin* to the lacing of the modified football of *Horkan*, the intent and objective of *Horkan* would be completely eliminated. Nothing would urge the young user's hands into the proper grasping position as taught and desired by *Horkan*. The interaction of the user's hands (at any location) would be no different than the user's fingertips, and interaction between a user's gloved hands (with Velcro® material positioned at the fingertips) and the lacing would not be enhanced. A grip of the ball to the young user would not be enhanced or improved only at the user's

fingertips. Replacement of the Velcro® fasteners with the projections of *Martin* as suggested by Pages 6 and 7 of the Office Action would NOT accomplish the stated objectives of *Horkan*. Rather, the objectives of *Horkan* would be completely unfulfilled.

In the Response to Arguments Section of the Office Action, the Office Action states that *Horkan* provides a football construction where the laces are modified in order to improve the gripping ability of the ball, noting column 1, lines 62-67 of *Horkan*. The Office Action goes on to state that the objectives of *Horkan* at column 1, lines 62-67 are to properly impart spin to a thrown football and to improve the user's grasping and controlling of the football.

The Office Action implies that *Horkan*'s objective is to modify the laces of a football in order to generally improve the gripping ability of the ball, including the ability to impart spin to a thrown football and to improve the user's grasping and controlling of the football.

Applicants' respectfully disagree with this characterization. In Col. 1, lines 62-67, two of *Horkan*'s objectives are listed and each of the objectives is directed to a "training aid, as foresaid." The training aid in one objective "properly imparts a spin to a thrown football," and in the other, the training aid "improves the user's grasping and control of the football."

*Horkan* specifically defines what "*training aid*" means. In the very first sentence of Col. 1, *Horkan* states "[t]his invention relates to a *training aid and, more particularly, to a modified football and glove combination ....*" (emphasis added).

*Horkan*'s objectives are solely directed to a training aid (the modified football and glove combination). As stated above, *Horkan* is very specific about the exact configuration of the modified football and the glove combination. The modified football includes one element of a Velcro® patch on the laces of the football, and a corresponding patch of Velcro® placed on the fingertips of the glove. *Horkan*'s objective and his disclosure are

entirely directed to improving the gripping of the fingertips of the gloved user with the laces of a football, in order to allow the user to impart a spin to a thrown football and improve the grasping and control of the football with his or her hand in the proper position (the gloved fingertips contacting the laces). The training aid of *Horkan* is intended to train the user to grasp a football correctly.

The objectives cited in the Office Action on Col. 1, lines 62-67 are directed to *Horkan*'s training aid and would not suggest to one of ordinary skill in the art to look at other arrangement for the laces that would generally improve the griping and controlling of the football to users hands. As stated above, *Horkan* requires increased engagement between the laces and the only the fingertips of the gloved user in order to train users (in particular young users) to properly grasp and throw a football. *Horkan* specifically requires hook and loop fasteners to accomplish his objective because the hook and loop (Velcro®) fastener design allows for the increased engagement to occur only between the mating surfaces of the gloved fingertips of the user and the laces of the modified football.

It is not *Horkan*'s objective, and it is not *Horkan*'s teaching, to generally increase the gripping ability of the laces of a football. Rather, as stated above, *Horkan* specifically teaches away from generally increasing the gripping ability of laces. *Horkan*'s objective is not to increase the gripping ability of the laces of a football to a user's palms, or a user's fingers in general. To do so, would defeat the purpose of *Horkan*'s training aid invention. *Horkan*'s training aid disclosure calls for an improved grip only at the fingertips to teach the user the correct way to hold a football.

The Office Action argues that the Velcro applied to the modified football of *Horkan* could be replaced with the pebbles of *Martin*. But, such a construction would not meet *Horkan*'s objectives. Applying pebbles to the laces would defeat *Horkan*'s objectives because it would not urge the users fingertips into proper engagement with the laces of the football, and therefore, would not train the user on the proper way to grasp a football. Rather, it would make the laces more grippable to the user's hands in general and not the user's fingertips. The

user would not be urged to place his or her fingertips at the laces to properly impart spin or to improve the grasping or control of the ball as required by *Horkan*.

*Horkan* addresses a very similar scenario in Col. 1, lines 32-40 where he explains that the prior art applied Velcro® strips to the outer surface of a football for interaction with a player wearing cotton gloves, but such an arrangement does not assure that the ball is properly grasped only at the laces by the fingertips of the user. Therefore, *Horkan* describes this similar scenario as a deficiency in the prior art. The replacement of Velcro material on the laces with pebbles, as proposed in the Office Action, fails for the same reason. Such a configuration does not satisfy *Horkan*'s consistent teaching and disclosure that the fingertips of the gloved user be urged or positioned at the laces. Applying pebbles to the laces does not make only the gloved fingertips of a user, or only the fingertips of a user, more grippable than the remaining portions of the user's hands, such as the user's palms. Referring to Col. 1, lines 9-22, *Horkan* specifically states that players holding the ball in a palm up fashion is improper and results in an incorrect passing technique. Again, *Horkan* specifically teaches a training aid that urges grasping of the user's gloved fingertips with the laces of a modified football in order to train the user on the proper way to grasp a ball. Making the laces more grippable to the hand as a whole does not accomplish *Horkan*'s objective. Accordingly, this argument presented in the Office Action of applying pebbles to the laces of the modified football of *Horkan* as an alternative to Velcro® is misplaced because it is contrary to the specific disclosure, objectives and teaching of *Horkan*. No suggestion, teaching or motivation exists in *Horkan* suggesting a combination with *Martin*.

Further, Applicants respectfully submit that the Office Action argument attempting to apply the pebbles of *Martin* to the laces of a football introduces impermissible hindsight. "The motivation-suggestion-teaching requirement protects against the entry of hindsight into the obviousness analysis ...." *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). One must guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention at issue. *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). *Martin* is

devoid of any teaching, suggestion or disclosure indicating that pebbles should be applied to anything but a basketball. *Martin* does not mention a football, let alone laces of a football. Further, as stated above, *Horkan* specifically teaches and discloses a training aid where a football modified with Velcro® material on laces is combined with gloves having corresponding Velcro® material at the fingertips. As discussed above, *Horkan* does not teach, suggest or disclose the use of pebbles on the surface of the laces and one of ordinary skill in the art would not look to *Martin* as an alternative to the Velcro® used by *Horkan* because such a substitution would be unworkable and would not meet the consistent objectives of *Horkan*. Absent the required motivation, suggestion or teaching, the argument presented in the Office Action is impermissible hindsight.

Accordingly, it is respectfully submitted that claim 1 overcomes the rejection based upon *Horkan* in view of *Martin*, and is believed to be in condition for allowance. It is also respectfully submitted that claims 2, 3, 5, 7, 9, 10 and 51-64, which depend from claim 1, are patentable over *Horkan* and/or *Martin* for at least the same reasons.

**2. REJECTION OF CLAIMS 4, 8 AND 12 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FEENEY**

Section 3 of the Office Action rejected claims 4, 8 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Feeney* (U.S. Patent No. 6,283,881). Claims 4, 8 and 12 depend from independent claim 1. It is respectfully submitted that claims 4, 8 and 12 are patentable over *Horkan* in view of *Martin* and *Feeney* for at least the same reasons as discussed above with respect to independent claim 1. *Feeney*, like *Martin*, discloses a game ball, such as a basketball, including a plurality of panels having projections. The projections of *Feeney* are generally formed in the shape of closed loops. *Feeney*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1. *Feeney* does not teach, suggest or disclose football lacings and does not teach, suggest or disclose applying its projections onto the lacing of a football. In particular, *Feeney* does not teach, suggest or disclose a football including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least

a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand.

*Horkan, Martin* and *Feeney*, alone or in combination, do not teach, disclose or suggest the game ball of claim 1. Accordingly, it is respectfully submitted that claims 4, 8 and 12, which depend from claim 1, are patentable over *Horkan, Martin*, and *Feeney* for at least the same reasons.

3. ***REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER HORKAN IN VIEW OF MARTIN AND FINLEY***

Section 4 of the Office Action rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Horkan* in view of *Martin*, and *Finley* (U.S. Patent No. 4,991,842). Claim 6 depends from independent claim 1. It is respectfully submitted that claim 6 is patentable over *Horkan* in view of *Martin* and *Finley* for at least the same reasons as discussed above relating to claim 1. *Finley* discloses a spherical basketball having a plurality of recesses formed on the exterior of the basketball and a network of interconnected ridges separating adjacent ridges. *Finley*, alone or in combination with the cited art, does not teach, suggest or disclose the combination of elements and limitations of claim 1. *Finley* does not teach, suggest or disclose lacings of a football and does not teach, suggest or disclose applying its plurality of recesses onto the lacing of a football. In particular, *Finley* does not teach, suggest or disclose a football including a casing and an outwardly extending lacing, having an exposed surface, coupled to the casing, wherein at least a portion of the exposed surface of the lacing has a pebbled texture that is highly grippable when directly contacted by a user's hand.

*Horkan, Martin* and *Finley*, alone or in combination, do not teach, disclose or suggest the game ball of claim 1. Accordingly, it is respectfully submitted that claim 6, which depend from claim 1, is patentable over *Horkan, Martin*, and *Finley* for at least the same reasons.

**4. REJECTION OF CLAIMS 1-14 AND 51-64 AS BEING PROVISIONALLY  
REJECTED ON THE GROUND OF NON-STATUTORY OBVIOUSNESS-TYPE  
DOUBLE PATENTING OVER CLAIMS 51 AND 53-65 OF COPENDING  
APPLICATION NO. 11/018,628**

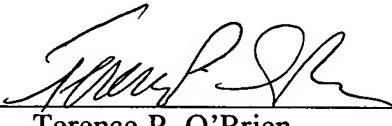
Section 6 of the Office Action provisionally rejected claims 1-14 and 51-64 under the judicially created doctrine of obviousness-type double patenting over claim 51 and 53-65 of copending Application No. 11/018,628. Applicants do not object to this provisional rejection and are prepared to submit a terminal disclaimer to obviate the double patenting rejection as necessary.

**5. CONCLUSION**

Applicants respectfully request reconsideration of claims 1-14 and 51-64. Applicants believe that the present application is now in condition for allowance. The Examiner is invited to telephone the undersigned to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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